

**REMARKS**

Claims 1-13 were pending in this application.

Claims 1-13 have been rejected.

No claims have been allowed.

Claims 1, 3, 4, 7, 9, 10, 12, and 13 have been amended as shown above.

Claims 2 and 8 have been cancelled.

Claims 14-20 have been added.

Claims 1, 3-7, and 9-20 are now pending in this application.

Reconsideration of the claims is respectfully requested.

**I. 35 U.S.C. § 102(e) – Anticipation**

The Office Action rejects Claims 1, 2, 7, and 8 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,133,911 to Kim (“*Kim*”). The Office Action also rejects Claims 1, 2, 7, 8, and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,623,613 to Rowe et al. (“*Rowe*”). The Office Action further rejects Claims 1, 2, 7, and 8 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,448,987 to Easty et al. (“*Easty*”). These rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed

invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claims 1, 7, and 13 recite a “first display area” containing menu items of a first menu level and a “second display area” containing menu items of a second menu level. Claims 1, 7, and 13 also recite that the first and second display areas each extends “along a border of a third display area.” Claims 1, 7, and 13 further recite a “connection indicator” connecting a “selected menu item of the first menu level” and a “menu item of the second menu level.”

The Office Action does not specify how *Kim*, *Rowe*, or *Easty* anticipates first and second display areas each extending along a “border” of a “third display area.” The Office Action also does not specify how *Kim*, *Rowe*, or *Easty* anticipates displaying a “connection indicator” that connects menu items, where the menu items reside in display areas that extend along borders of a third display area. As a result, the Office Action does not establish that *Kim*, *Rowe*, or *Easty* anticipates the Applicants’ invention as recited in Claims 1, 7, and 13.

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejections and full allowance of Claims 1, 7, and 13.

## **II. 35 U.S.C. § 103(a) – Obviousness**

The Office Action rejects Claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,029 to Ohkura et al. (“*Ohkura*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to

make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

*Ohkura* recites a television receiver capable of generating a display that horizontally lists channel categories. (*Abstract; Figures 16-19*). When a particular category is selected, channels in that category are listed in a vertical column under the selected category. (*Abstract; Figures 16-19*). The vertical column usually appears under the leftmost category in the display. (*Abstract; Figures 16-18*). The vertical column could also appear under another category, although this poses problems because it obscures an image. (*Col. 10, Lines 1-7; Figure 19*). A cursor (element K) is used to select a channel contained in the vertical column. (*Col. 10, Lines 24-32*).

*Ohkura* fails to disclose, teach, or suggest the use of a “connection indicator” that connects menu items displayed in different “display areas,” where those display areas each extends along a “border” of a “third display area” as recited in Claims 1, 7, and 13. There is no disclosure, teaching, or suggestion in *Ohkura* of any indicator that connects the selected category in the horizontal list and a channel in the vertical column. The cursor of *Ohkura* does not represent the “connection indicator” recited in Claims 1, 7, and 13 because the cursor simply identifies a channel in the vertical column, rather than connecting the selected category in the horizontal list with a channel in the vertical column.

Moreover, there is no motivation to make such a modification to *Ohkura*. As shown in Figures 16-19 of *Ohkura*, the vertical column of channels always lies below the selected category in the horizontal list. When another channel category is selected, either the vertical column remains in the same place and the categories in the horizontal list are shifted, or the

vertical column moves so that it lies below another category. In either case, the vertical column lies below the selected category. There is no need to add a “connection indicator” to the display of *Ohkura* because it is always clear which channel category is associated with the vertical column. Because there is no need to add a “connection indicator” to the display of *Ohkura*, one of ordinary skill in the art would not be motivated to modify *Ohkura* to reach the Applicants’ invention.

As a result, *Ohkura* fails to disclose, teach, or suggest the Applicants’ invention as recited in Claims 1, 7, and 13. Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejection and full allowance of Claims 1, 7, and 13 (and their dependent claims).

### III. NEW CLAIMS

The Applicants have added new Claims 14-20. The Applicants submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 14-20.

**SUMMARY**

For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: \_\_\_\_\_

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